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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/168,072 10/08/98 MARCHESANI

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EXAMINER

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ART UNIT

PAPER NUMBER

3711

DATE MAILED:

01/10/01

13

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/168,072**

Applicant(s)  
**Marchesani**

Examiner  
**William M. Pierce**

Group Art Unit  
**3711**



☒ Responsive to communication(s) filed on Dec 15, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-11 and 13-28 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-11 and 13-28 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

**WILLIAM M. PIERCE**  
PRIMARY EXAMINER

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

1. The finality of the previous office action is withdrawn in view of the error made in composing and reapplying Potter. Breeding is properly applied to conform to examiner's remarks of the previous office action. Further, Shen and Srichayaporn has been applied in view of applicant's newly presented claim 28.

2. Claims 1-5, 10, 11, 17-21, 22-24 and 26-28 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Srichayaporn.

3. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srichayaporn.

Operating a game as a player/banker is discussed by Srichayaporn. To retain 5% is old and a matter of choice.

4. Claims 6, 9, 13-16 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srichayaporn in view of Malek and Franklin. 6, 9, 13 and 25 Purchasing a card is old as called for by Franklin. As to claim 15, he teaches the dealing of three cards with a single replacement card available. Purchasing replacement cards is old. Malek is another teaching of such. The number of cards dealt is an obvious matter of choice. Indication that such is not critical to applicant's invention is in the numerous embodiments as to the number of cards dealt in claims 14-16. Hedman teaches the dealing of five cards and teach that the number of cards is not critical.

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5. Claims 1-5, 7, 8, 10, 11, 17, 18-21, 22-24 and 26-28 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shen et al.

Operating a game as a player/banker is discussed by Srichayaporn. To retain 5% is old and a matter of choice.

6. Claims 6, 9, 13-18 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shen in view of Malek and Franklin.

Purchasing a card is old as called for by Franklin. As to claim 15, he teaches the dealing of three cards with a single replacement card available. Purchasing replacement cards is old. Malek is another teaching of such. The number of cards dealt is an obvious matter of choice. Indication that such is not critical to applicant's invention is in the numerous embodiments as to the number of cards dealt in claims 14-16. Hedman teaches the dealing of five cards and teach that the number of cards is not critical.

7. Claims 1-5, 7-11, 13-20, 22, 23 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breeding.

Claims 1, 4, 5, 10 and 11 are conventional Asian or Pai Gow poker as shown in Breeding. Hands are dealt (bottom col. 4) and split into two half hands having a high and low and wagers are made before viewing cards (col. 5, ln 14). The only difference is how the players are declared

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the winner. In Breeding, the winner must have a higher ranking hand than the bank in both the high and low hands. Thus, the difference is only in the “winning scheme” one uses to compare cards in order to resolve the bets. Such amounts to the rules of play and the conditions that must be met in order for a player to prevail on a wager. For a player to prevail in applicant’s game, a player’s high hand must be greater than the bank’s (as in conventional Asian Poker) and the low hand must be lower (different from conventional Asian Poker where such would result in a “push”). To have changed the “winning scheme of Breeding to allowing a player to prevail where his high hand is higher than a bank’s but his low hand is lower than the bank’s would have been an obvious matter of design choice. There is no evidence where such is critical to the claimed invention by solving any particular problem or producing any unexpected results. In evaluating Breeding, it is proper to take into account not only the specific teaching of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In *re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). In Breeding, choosing a “winning scheme” is recognizably infinite. One could call for “special cards” such as jokers to be present, the hand to have at least an ace, both hands to be lower in rank than the bank’s, the high hand to be lower and the low hand to be higher and etc. Choosing any “winning scheme” would not change the play. Such would only change the odds for payout which can be determined mathematically. In line with this rationale, the conclusion of obviousness may be made from “common knowledge and common sense” of the person of ordinary skill in the art (see *In re Bozek*, 416 F. 2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)) and more importantly that skill

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is presumed on the part of those practicing in the art (In re Sovish, 769 F.2d 738, 743, 226 USPQ 771 (Fed. Cir. 1985). In applying such guidance on obviousness, the subject matter as claimed would have been obvious to one of ordinary skill in the art at the time the invention was made.

Examiner reaches this conclusion based upon the following factors.

First, Breeding shows all of the claimed method except for how the winner is resolved and choosing a winning scheme when comparing cards in wagering games are related only to common knowledge of one skilled in wagering games. For example, note the numerous variations of poker (i.e. high/low, wild, low ball and etc.) and Nguyen who teaches there a “winning scheme” may be chosen “arbitrarily”.

Second, to the determination is that choosing a different winning scheme does not change the game. It only changes the strategy and odds in a known and expected way that is within the skill of one practicing in the art.

Third, Breeding give a “winning scheme” according to a preferred embodiment. One can infer from a level of knowledge in wagering game such as Poker that he realized that this was not the only “winning scheme” that he recognized as being workable with his method of play. That changing the “winning scheme” would not alter his game in an unexpected way.

As to claim 2, conventional Pai Gow poker uses two hands of two cards. See col. 1, ln. 25 of Breeding. Further, Shen, although not applied, teaches such a splitting of cards in a similar type game. Claim 3 is within the scope of the “ante” bet common and well known to wagering games. The claimed values in 7-9 are considered obvious matters of choice since they are not

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shown to be critical to the claimed invention by solving any particular problem or producing any unexpected results. When a dealer can draw, as called for in claim 13, and the number of cards dealt as called for in claims 14-16 are an obvious matter of choice further not shown to be critical. As to claims 17 and 18, Player/Banker formats to wagering games are old and well known in order to eliminate the house participation. Note Wolf.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Breeding in view of Malek.

Breeding fails to show discarding and paying for an extra card. Malek teaches that one can take chances on bettering his hand by paying for an extra card. To have allowed the step of paying for a replacement card in a game method like that shown by Breeding would have been obvious in order to allow a player to try and better his hand.

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Breeding in view of Banyai.

To have provided a bonus award dependent upon the meld of a players hand would have been obvious as taught by Banyai in order to increase player interest.

10. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breeding in view of Lo.

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Breeding's layout fails to show indicia to the play of the game. It is old to provide indicia relating to the play of the game on the layout in order to remind the players. Lo shows this by way of example.

11. Applicant's arguments filed 12/15/00 have been fully considered but they are not persuasive.

Applicant's remarks with respect to Potter are now considered moot since his application to the claims has been withdrawn.

The winning scheme of Breeding anticipates applicants' claimed invention. Considering the whole disclosure. Breeding shows two hands of two cards is know when Pai Gow tiles are replaced by conventional cards. (Col. 1, ln. 25). This clearly anticipates applicants' two "half hands". Examiner sets forth that the combining of the teaching references applied are proper in that they show variations of the high and low game type that is being claimed. Such are representative of what is know to the art as a whole.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ung and Sum Chau shows applicants game with the exception of using a standard deck of cards.

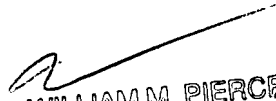


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13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication should be directed to William Pierce at E-mail address [bill.pierce@USPTO.gov](mailto:bill.pierce@USPTO.gov) or at telephone number (703) 308-3551.

  
WILLIAM M. PIERCE  
PRIMARY EXAMINER

**ATTACHMENT TO AND MODIFICATION OF**  
**NOTICE OF ALLOWABILITY (PTO-37)**  
**(November, 2000)**

**NO EXTENSIONS OF TIME ARE PERMITTED TO FILE CORRECTED OR FORMAL DRAWINGS, OR A SUBSTITUTE OATH OR DECLARATION**, notwithstanding any indication to the contrary in the attached Notice of Allowability (PTO-37).

If the following language appears on the attached Notice of Allowability, the portion lined through below is of no force and effect and is to be ignored<sup>1</sup>:

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to comply will result in ABANDONMENT of this application. ~~Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).~~

Similar language appearing in any attachments to the Notice of Allowability, such as in an Examiner's Amendment/Comment or in a Notice of Draftperson's Patent Drawing Review, PTO-948, is also to be ignored.

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<sup>1</sup> The language which is crossed out is contrary to amended 37 CFR 1.85(c) and 1.136. See "Changes to Implement the Patent Business Goals", 65 Fed. Reg. 54603, 54629, 54641, 54670, 54674 (September 8, 2000), 1238 Off. Gaz. Pat. Office 77, 99, 110, 135, 139 (September 19, 2000).